

Appl. No. 10/767,668
Amdt. Dated 1/31/2005
Reply to Office Action of Jan. 12, 2005

REMARKS/ARGUMENTS

Please cancel claims 15, 16, 19 and 20 without prejudice

Newly presented claim 21 is directed to a method of forming a multi-component yarn which should be grouped with the claims of Groups II and IV of the below discussed restriction requirement. Claim 21 is generic to the methods of both Groups.

Assumedly, in response to applicant's traverse of 10/21/04, the restriction requirement of 9/01/04 is here modified.

Restriction to one of the following inventions is required under 35 USC 121.

- I. Claims 1-12 are said to be drawn to a conductive yarn properly classified in Class 428, subclass 373.
- II. Claims 13-14 are said to be drawn to a method of forming a multi-component yarn properly classified in Class 264, subclass 172.11
- III. Claims 15, 16, 19 and 20 are now cancelled leaving no Group III.
- IV. Claims 17 and 18 are said to be drawn to a forming of a multi-component yarn properly classified in Class 264, subclass 173.12.

The restriction states that Groups I, II, IV are distinct if the process, as claimed, can be used to make a different product or if the product, as claimed, can be made by another process. It is asserted that the product can be made by different processes, as evidenced by Groups II and IV.

This holding is respectfully traversed as improper. As set forth on pages 3-5 of the specification, there is only a single invention presented for consideration, i.e. a multi-

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component conductive yarn with a first component consisting of a polymeric material and a second component consisting of a polymeric material combined with carbon nanotubes. Article claims 1-12 are directed to that product, and method claims 15-16 and 19-21 are restricted to the method of forming that product.

Further, it is argued that no extra burden is placed on the PTO because any complete search of the claims of Group I, II or IV must include both Class 428/373 and Class 264/173 all indents.

It is stated that Groups II and IV are unrelated inventions if it can be shown that they are not disclosed as capable of use together and have different modes of operation. MPEP 806.04 is cited.

This holding is respectfully traversed.

MPEP 806.04 states two combinations disclosed having different functions are independent inventions. The example is a process of painting a house and of boring a well.

Clearly, the claims of Groups II and IV do not fit the example. Clearly, the claims of Groups II and IV are directed to the single invention, i.e. a method of forming a multi-component conductive yarn.

Again, prosecution of combined claims 13, 14, 17, 18 and 21 places no additional burden on the PTO, as all cited classes and subclasses must be searched.

Finally, it is urged that, at best, claims 13, 14 constitute a first species, while claims 17, 18 constitute a second species of forming the yarn disclosed. Newly

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presented claim 21 comprises a generic claim linking the species.

Accordingly, it is respectfully urged that the restriction requirement as set forth be withdrawn and claims 1-14, 17, 18 and 21 given an action on their merits.

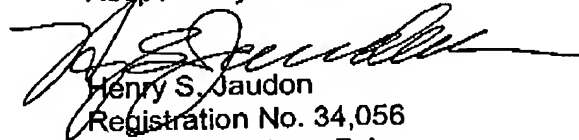
In accordance with MPEP 818, applicant elects with traverse the claims of Group I, i.e. claims 1-12 for prosecution.

With the election of Group I an election of species is also required.

The requirement states that election between the variable primary component polymeric materials set forth in claims 2 and 3 be made. Accordingly, "polyester" is provisionally elected.

An action on the merits is respectfully requested.

Respectfully submitted,



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